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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/783,072 | 02/15/2001 | Takayuki Tsuboi | 35.C15131 | 3809 |

5514 7590 10/22/2002

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EXAMINER

BLACKMAN, ROCHELLE ANN J

ART UNIT

PAPER NUMBER

2851

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/783,072 | TSUBOI ET AL. | |
| | Examiner | Art Unit | |
| | Rochelle Blackman | 2851 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 June 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-15, 17-28 and 30-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1-15 and 17-28 is/are allowed.
- 6) Claim(s) 1-15, 17-28, and 30-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 15 February 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 1/2.
- 4) Interview Summary (PTO-413) Paper No(s) _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other:

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-15, 17-28, and 30-32 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Berge et al., PCT Publication No. WO99/18456.

Berge discloses a "photo-taking device"/ an "imaging optical system"/ an "image pick-up means"/ an "optical system in which a predetermined image is formed or light of the image is converged by a lens element, said optical system comprising a variable-power element/optical element incorporated in the lens element" having a "container"(see Figs. 1-6); "first and second liquids...differing substantially from each other in refractive index...without mixing with each other...making the boundary between said first and second liquids having a rounded shape"(see 11 and 13 of Figs. 1-6 and pg. 12, lines 4-6); and an "electrode..."(see 16, 17, 26, and 75-79 of Figs. 1-6).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15, 17-28, and 30-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,449,081. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed "optical device"/ "photo-taking device"/ "image pickup means" is met by the patented "optical device"; the claimed "optical element"/ "variable-power optical element" is met by the patented "optical element"; the claimed "optical system"/ "imaging optical system" is met by the patented "optical system"; the claimed "container" and "first and second fluids" are met by the patented "first fluid and second fluid being confined in a sealed space created between the first support and second support"; the claimed "electrode"/ "first electrode" and "second electrode" is met by the patented "first electrode" and "second electrode"; and the claimed "voltage application circuit for applying a voltage to said electrode, wherein the shape of the boundary between said two liquids is changed by application of a

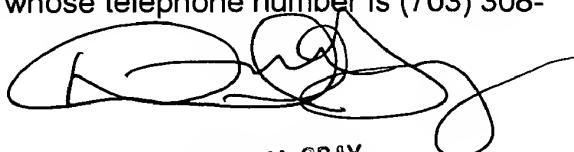
voltage through said electrode to change the quantity of transmitted light in the bundle of rays passing through said optical element"/ an "application circuit for applying a voltage to said electrode, wherein the shape of the boundary is changed by application of a voltage to change the refractive power with respect to light passing through said optical element" is met by the patented "...varying a voltage applied to said second fluid, the shape of an interface between said first fluid and second fluid is altered, so as to change an amount of light passing through said optical element". The claimed features and functions of the claimed elements are similarly met by the patented features and functions of the patented elements.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rochelle Blackman whose telephone number is (703) 308-2879. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Russell Adams can be reached on (703) 308-2847. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DAVID M. GRAY
PRIMARY EXAMINER